

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/808,002	03/15/2001	Robert Stanley Arling	10010131-1	4587

24737 7590 06/29/2005

PHILIPS INTELLECTUAL PROPERTY & STANDARDS
P.O. BOX 3001
BRIARCLIFF MANOR, NY 10510

EXAMINER	
BLECK, CAROLYN M	
ART UNIT	**PAPER NUMBER**
3626	

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/808,002	Applicant(s) ARLING ET AL.	
	Examiner Carolyn M. Bleck	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 January 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 12 May 2005. Claims 1-23 are pending. Claims 1-15 have been amended. Claims 21-23 are newly added.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Under the statute, the claimed invention must fall into one of the four recognized statutory classes on invention, namely, a process (or method); a machine (or system); an article of manufacture; or a composition of matter.

(A) Claims 1-7 appear to be directed toward an electronically generated and computer-readable medical report. However, it is unclear as to which recognized statutory class of invention the database report of claims 1-7 is directed. In particular, a report is not a process or method as it lacks a series of steps. A report is not a machine or system as there is no specific recitation of machine or system components. A report is not recognized as a composition of matter. A report, per se, is merely a collection of data.

Under the guidance of recent case law, the requirements of 35 U.S.C. 101 are met when "the practical application of the abstract idea produces a useful, concrete, and tangible result" (State Street Bank & Trust Co. vs. Signature Financial Group, Inc., 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998)). However, the claims, as presently recited, do not appear to have a tangible result. Data structures or computer programs, in general, that are not claimed as embodied in computer-readable media are descriptive material per se, and are not statutory because they are not capable of causing functional change in a computer.

In particular, it is unclear whether the report, as recited in claims 1-7, is embodied on a specific readable medium within the technological arts (and thus tangible), since it appears the report is simply computer-readable. Such claimed data does not define any structural and functional interrelationships between the data and other claimed elements of an apparatus, which permit the purpose of the data to be realized (see MPEP section 2106 section IV, B, 1, (a) for further guidance). Simply stated, how is the claimed report tangibly embodied within a system and how is that embodiment structurally related to a system?

In light of the above, it is respectfully submitted that the claimed invention, although useful and concrete, is not tangible, and thus fails to recite the practical application of an abstract idea to satisfy the requirements of 35 U.S.C. 101.

(B) Claims 2-7 fail to also disclose any structural element that would produce a concrete and tangible result, and thus also fail to pass muster under 35 U.S.C. 101.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-4, 6-11, 13-18, and 20-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Stoodley (6,611,846).

(A) As per claim 1, Stoodley discloses a report downloaded to a computer (col. 15 lines 4-16) comprising:

(a) a diagnosis list of stored diagnoses to be selected by a user on a computer (see Fig. 2A and 2D, col. 10 lines 11-30);

(b) fields in the report displaying test results for a given patient, wherein the results are listed in a table, wherein the results are retrieved and inserted into the table or fields of the table from the central server (Fig. 2A, 2D, 8, col. 10 line 66 to col. 11 line 6, col. 15 lines 4-16, col. 15 lines 29-67, col. 17 lines 5-15).

It is respectfully submitted that inserting the results into the table with fields is considered to be a form of "the measurement replacing the field."

(B) As per claim 2, Stoodley discloses a list of a plurality of defined values associated with one or more measurements (see Fig. 2d and col. 10 line 66 to col. 11 line 6).

(C) As per claim 3, Stoodley discloses 1) by entering the patient's date of birth, the age of the patient is automatically calculated and entered in the age field, 2) calculating the total number of particular patient data and displaying the total number, and/or 3) graphing a plot of velocities of blood flow rate (cm/sec) within the selected vessels over a course of dates (see Fig. 2d, col. 10 lines 1-10, col. 10 line 66 to col. 11 line 31, col. 17 lines 35-52).

(D) As per claim 4, Stoodley discloses the measurement being a data and a duration.

(E) As per claim 6, Stoodley discloses in a related diagnosis field, the use may select from a list of diagnoses previously entered for the patient in the diagnoses screen (Fig. 2B (see 80), col. 10 lines 30-50).

(E) As per claim 7, Stoodley discloses the categories including clinical presentation, pathology, anatomy, treatment, and outcome (col. 4 lines 18-39).

(F) As per claim 8, Stoodley discloses a system including a database for analyzing medical patient data (col. 17 lines 3-5) comprising:

(a) a computer for producing a report, wherein the computer includes a browser for requesting a search query and wherein a medical report is generated based on the search query (col. 15 lines 4-67).

The remaining features of claim 8 are disclosed in claim 1, and incorporated herein.

(F) Claims 9-11, 13-14, 15-18, and 20 repeat the same limitations as claim 1-4 and 6-7, and are therefore rejected for the same reasons given for those claims, and incorporated herein.

(G) As per claims 21-22, Stoodley discloses the patient data, including measurements, being retrieved in a storage unit (Fig. 2D, 8, col. 15 lines 29-46).

(H) As per claim 23, Stoodley discloses an application being downloaded for carrying out the method of claim 15 (col. 15 lines 4-16).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 5, 12, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stoodley (6,611,846) as applied to claims 1, 8, and 15, and further in view of Wood et al. (5,851,186).

(A) As per claims 5, 12, and 19, Stoodley fails to expressly disclose the report updating the measurement at the time the report is generated and every time the report is viewed.

Wood discloses a system wherein by clicking on the update button, the HTTP server and CGI programs of the ultrasound system update the remotely displayed image with the ultrasound image produced most recently by the ultrasound system (col. 11 line 29 to col. 12 line 11).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Wood within the system of Stoodley with the motivation of allowing physicians to perform exams and review information remotely (Wood; col. 11 line 54 to col. 12 line 11).

Response to Arguments

8. Applicant's arguments filed 12 May 2005 have been fully considered but they are not persuasive. Applicant's arguments will be addressed below in the order in which they appear in the response filed 12 May 2005.

(A) Applicant argues at pages 6-7 of the response filed 12 May 2005, that Applicant's feature of "automatic generation and insertion of a detected medical characteristic" is different than the prior art. Examiner respectfully disagrees. The Stoodley reference teaches inserting results into a table with fields in a report Fig. 2A, 2D, 8, col. 10 line 66 to col. 11 line 6, col. 15 lines 4-16, col. 15 lines 29-67, col. 17 lines 5-15). The Examiner notes that in this report generation the data is "automatically" inserted into a field by the computer.

In response to applicant's argument that Wood cannot be combined into Stoodley, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (571) 272-6767. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (571) 272-6776.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

11. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(703) 872-9306 or (703) 872-9326 [Official communications]

(703) 872-9327 [After Final communications labeled "Box AF"]

(571) 273-6767 [Informal/ Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to the Knox Building, Alexandria, VA.

CB
June 15, 2005

JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600